

Application Serial No. 09/919,339
Attorney Docket No.: 60003.0001USU1

REMARKS

This Amendment is in response to the Office Action mailed March 2, 2006 (hereinafter the "*Action*"). Claims 1-22 were examined in the *Action*. Claims 1-22 were rejected. No new claims have been added. Applicants respectfully request reconsideration and examination in view of the following remarks.

Claim rejections-35 U.S.C. § 112, Second Paragraph

Claims 1-16 were rejected under 35 U.S.C. 112, second paragraph for failing to particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention.

Specifically, the *Action* states:

In particular, claim 1 recites "inputting information ... onto a server Website". There are several potential many of "website" that would cause the claim to be interpreted differently depending on which meaning was adopted. For instance, a website could be the content displayed on a web page; the various links attached to a so-called "home page"; files stored on certain server hardware; and so on. Another reasonable interpretation of the phrase "server Website" could be a website whose content pertains particularly to the subject of servers. However, the context of the claim as a whole, for instance in view of the preamble of claim 1, does not strongly support this interpretation. Correction is required. For the purpose of examination, the Examiner will interpret the phrase "server Website" to read "server."

Claims 1, 2, 5-7, 10, 15, and 16 have been amended to further define and clarify the claimed invention in accordance with the *Action's* remarks and do not narrow the claimed subject matter. Applicants respectfully submit that the amendments to claims 1, 2, 5-7, 10, 15, and 16 overcomes this rejection of claims 1-16, adding no new matter and placing claims 1-16 in condition for allowance.

Claim rejections-35 U.S.C. § 103

Claims 1-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (PG Pub# US 2002/0010604) (hereinafter "*Taylor*") in view of McCormack et al (US Pat# 6,049,773) (hereinafter "*McCormack*").

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Claim 1

Regarding claim 1 the *Action* states:

Taylor discloses a computer-implemented method for generating historical claim loss data reports that combine loss data from multiple insurance carriers over multiple years for insured parties comprising the steps of:

(a) inputting information about the insured onto a server Website (Taylor: inputting, [0008]-[0013]; [0045]-[0046]; Fig 2; server, [0066]; Fig 4, items 18 and 26));

(b) obtaining an authorization from the insured party (Taylor: [0050]);

(f) distributing the reports to the user (Taylor: [0053]).

Taylor suggests but fails to explicitly disclose

(c) querying loss data from at least two carrier databases;

(d) storing the queried loss data in a standard formatted form

(e) generating a standardized report, wherein the report combines loss data from the at least two carrier databases; and

However, these features are well known in the art as evidenced by the teachings of McCormack. McCormack discloses

(c) querying loss data from at least two carrier databases (McCormack: col 6, ln 58 to col 7; col 12, lns 61-65; Fig 3, items 100-500 show multiple databases which the Examiner notes are operated by a carrier, col 3, lns 47-52);

(d) storing the queried loss data in a standard formatted form (McCormack: col 7, lns 10-14; Fig 3, item 2000)

(e) generating a standardized report, wherein the report combines loss data from at least two carrier databases (McCormack: col 4, lns 51-53; col 23, lns 3-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of McCormack with the disclosures of Taylor with the motivation of utilizing the approaches of neural networks and fuzzy logic (McCormack: col 3, lns 25-37) to more efficiently match every tenant, owner, and insurance coverage (Taylor: [0021]) in the absence of complete information (McCormack: col 2, lns 52-55).

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Applicant respectfully traverses the *Action's* rejection. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. MPEP §2143; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996).

The references used in the *Action* fail at least the first prong of obviousness in that there is no suggestion or motivation to combine the reference teachings. Applicants admit that the references are in the same field as Applicants' invention, insurance. As a motivation to combine the *Action* sets forth that: one of ordinary skill would be motivated to utilize the approaches of neural networks and fuzzy logic as taught by *McCormack* (*McCormack*: col. 3, lns 25-37) to more efficiently match insurance coverage, as taught by *Taylor* (*Taylor*: [0021]), in the absence of complete information, as taught by *McCormack* (*McCormack*: col. 2, lns 52-55). Applicants respectfully submit that there is no motivation to combine the teachings of *McCormack* and *Taylor*. *McCormack* states that: "a method is needed to identify those claims *which have not been appropriately labeled*" (col. 2, lines 52-55), and that fuzzy logic is used to deal with *uncertainty of a neural networks ability to classify and to pattern match*, and "neural network[s] are not based on rules and logic structures" (col. 3, lines 26-35) (Emphasis Added). *Taylor* teaches an apparatus that employs a computer processor to *cross-index and sort databases* (*Taylor* [0021]). *Taylor* does not advocate the need for a system to handle uncertainty in classifying data or possible uncertainties involved with pattern matching. In contrast, *Taylor* teaches away from such a system combination by teaching that incomplete data is summarized into missing information reports and sent to an agent of the insurance carrier and said missing information is provided by said agent (*Taylor* [0021]).

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In further support of the lack of motivation to combine, *McCormack* is teaching that fuzzy logic and neural networks are needed for methods to identify claims that *have not been appropriately labeled* (*McCormack* col. 2, lns 52-54). The technology disclosed in *Taylor* is simply an apparatus that *cross-indexes and sorts databases* for compiling a list of missing information (*Taylor* [0021]). *Taylor* does not teach, suggest, or even contemplate that a system and/or method is needed to identify items that have not been appropriately labeled or that the system and/or method should be able to deal with uncertainties. *Taylor* uses logic and structure to cross-index and sort databases to summarize incomplete data. After the incomplete data is summarized it is forwarded to a person (i.e. an agent) to be completed. There is no suggestion or contemplation in *Taylor* that inferences are made concerning uncertainty or pattern matching by a computer system, rather a person clarifies uncertainties.

As set forth in the MPEP §2143.01(III) citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) “[t]he fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination.” Applicants’ respectfully submit that the references do not “suggest the desirability of the combination.” Contrary to the suggestions required, *Taylor* teaches away from a combination with *McCormack* by advocating that an agent supplies missing information and make inferences, and does not have a system as, disclosed by *McCormack*, which deals with uncertainty involved in pattern matching.

While Applicants do not believe there to be any teachings or suggestions in either reference that *Taylor* and *McCormack* should be combined to produce Applicants’ invention, assuming such a combination is warranted, the combination would not produce Applicants’ invention. *Taylor* simply sorts and cross-indexes *existing data*. *McCormack* teaches the use of fuzzy logic and neural network to deal with the *uncertainty of a neural network’s ability to classify and pattern match*. When the systems disclosed in *Taylor* and *McCormack* are combined, the resultant system is not the claimed invention.

Regarding the *Action’s* statement that: “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of

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McCormack with the disclosures of Taylor.” Applicants respectfully submit that MPEP §2143.01(IV) citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) states: “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references.”

In light of the above remarks, Applicants respectfully submit that the *Action* has failed the first prong of obviousness in that there is no suggestion or motivation to combine the cited references. Accordingly Applicant respectfully request withdrawal of the rejection of independent claim 1.

Should the Examiner find the above remarks non-persuasive, Applicants respectfully submit that the combined references used in the *Action* additionally fail the third prong of obviousness, because *Taylor* and *McCormack* do not teach or suggest all of the limitations of claim 1. Amended claim 1 is patentably distinguishable over the cited references for the reason that, *inter alia*, it recites querying loss data from databases wherein each database is maintained by a different carrier.

Per the *Action*, *Taylor* does not teach or suggest querying loss data from databases maintained by different carriers. The *Action* cites *McCormack* col. 6, lns 58 to col. 7; col. 12, lns 61-65; as support for databases. *McCormack* col. 12 lns 61-65 discloses that “[a] hypothetical city is given a longitude and latitude which is equal to the average longitude and latitude of every city in the state. Thus, the earth position of the hypothetical State Average city typically will be somewhat close to the center of the state.” Applicants respectfully submit that the cited section has nothing to do with databases. In *McCormack* at col. 6, lns 58 to col. 7, there is a description of Fig 3 and items 100-500 describing a block diagrammatic representation of the overall system. Items 100-500 in Fig 3 show databases “which the Examiner notes are operated by a carrier, col. 3, lns 47-52)” (Emphasis Added). Neither Fig 3 nor the text of *McCormack* disclose or suggest that the databases are maintained by more than one organization (i.e. various insurance carriers) or that the databases are accessible via a network such as the internet. Applicants’ invention discloses “a plurality of carrier databases 120. The carrier databases are owned and operated by insurance carriers, e.g. AIG, CAN, and

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Travelers" (Applicants' disclosure page 5, lines 21-26; and FIG. 1). Furthermore, Applicants' disclosure indicates that the server and carrier databases communicate by means of a wide range network communications mechanism 125, e.g., ATM, TCP/IP, and the Internet (Applicants' disclosure page 6, lines 1-3).

MPEP §2143.03 citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) states that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested." Applicants respectfully submit that *McCormack* and *Taylor* fail to teach or suggest all claim limitations. In *McCormack*, querying loss data from databases maintained by insurance carriers does not happen, rather an entity can query a database operated by a single carrier (*Action*, page 4, lns 13-15). Per the *Action's* admissions, *Taylor* does not overcome this deficiency of *McCormack* (*Action*, page 4, lns 6-7).

In conjunction with Applicants' remarks concerning combination of *Taylor* and *McCormack*, *supra*, Applicants' respectfully submit that combining *Taylor* with *McCormack* would not have lead to the claimed invention because *Taylor* and *McCormack*, either individually or in combination, *inter alia*, do not disclose or suggest querying loss data from a plurality of databases, each of which is maintained by a single carrier, as recited by amended claim 1.

Furthermore, the *Action* states that *Taylor* discloses obtaining an authorization from the insured party and points to *Taylor* paragraph [0050] for support. Applicants respectfully disagree. At paragraph [0050] *Taylor* discloses:

[0050] **FIGS. 5 through 9** are a series of flow sheets illustrating an example of a preferred method for purchasing and issuing ROI and TOI insurance employing a copyrighted software program entitled "Residents Insurance Network" produced by Integrated Business Solutions of Salt Lake City, Utah for use with a global information network 12. To enter the Residents Insurance Network (RIN) website, the internet user will log in and be forwarded to a main page information with the ability to click on links that go to the Frequently Asked Questions page, the Contact Us page, and the How It Works page. Also on the main page will be a universal login to allow secure access to administration pages. The web site will be laid out in a very simple format to allow easy maintenance and

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fast download times with the ability to customize the look and feel. See FIG. 10 for an example. (*Taylor*, paragraph [0050].)

Applicants respectfully submit that *Taylor* is merely disclosing a method for purchasing insurance in which a user logs into a main website. Upon logging into the main website the user can contact the insurance provider, view frequently asked questions, as view a "How It Works" page. Logging into a website is not obtaining an authorization from the insured as claimed. An embodiment of the Applicants' invention discloses obtaining authorization as:

The authorization procedure of the preferred embodiment begins with the server generating, through an application stored on the server, an authorization letter (Step 220). The generated authorization letter is unique in that each authorization letter includes a unique tracking number or bar code. The user prints out the authorization letter (Step 225). The user then obtains the insured's signature on the authorization letter (Step 230) and returns the signed authorization letter via facsimile to the routing system (Step 235). While the preferred embodiment uses only one authorization letter per insured, other embodiments may use a plurality of authorization letters per insured. (Applicants' disclosure page 11, lines 9-17.)

In light of the above remarks, Applicants respectfully submit that the *Action* has failed both the first and third prongs of obviousness in that there is no suggestion or motivation to combine the cited references and the cited references do not teach or suggest all the claim limitations. Accordingly Applicant respectfully request withdrawal of the rejection of independent claim 1.

Regarding the *Action's* additional assertions toward claims 2-6, 7-10 and 11-16, which have not been addressed specifically, Applicants do not acquiesce to said assertions and reserves the right to later present arguments against said assertions. Furthermore, Applicants' submit that the *Action's* rejection of claims 2-6, 7-10 and 11-16 are moot in view of there dependency on claim 1 which, as amended and in view of the above remarks is in condition for allowance. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2-6, 7-10 and 11-16 in view of there dependency on claim 1.

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Claim 7-10

Regarding claim 7-10 the *Action* states:

Claims 7-10 are rejected under 35 U.S.C 103(a) as being unpatentable over Taylor in view of McCormack and further in view of Applicant's admitted prior art submitted in the discloser for the current application (hereinafter APA).

As per claim 7, the combined teachings of Taylor and McCormack teach the method according to claim 1, wherein the step of obtaining an authorization from the insured party comprises the steps of:

generating (from application software), printing and storing insurance-related information from an insured or potentially insured (Taylor: [0028]-[0029]); and

collecting information from a user via a plurality of channels (Taylor: [0012]-[0013]);

The combined teachings fail to explicitly teach the above steps as applied to "authorization letters" which pertain to obtaining authorization from an insured to disclose loss data from the insured's history, namely

generating authorization letters on an application on the server Website;

printing authorization letter;

obtaining insured signatures on letters;

returning authorization letters via facsimile; and

storing authorization letters.

However, these features are well known in the art as evidenced by APA (APA: pg 2, lns 16-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of Applicant's admitted prior art with the combined teachings of Taylor and McCormack with the motivation of allowing more efficient and complete collection of tenant information in order to assure compliance with renter's agreements requiring a tenant to maintain insurance (Taylor: [0005]).

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Applicants respectfully traverse this rejection. Information provided in the "Background" section of Applicants disclosure is not an admission of prior art. The headings used in an application are for organization purposes and should not be construed as an admission of any kind. In addition, MPEP §601.01(c) states that the "Background of the Invention" is a description of the related art including information disclosed under 37 C.F.R §§1.97 and 1.98 (Information Disclosure Statements). 37 C.F.R. §1.97(h) states that: "[t]he filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in §1.56(b)." Furthermore, the "Background" section of Applicants disclosure makes no reference of using facsimile means to transmit, route authorization letters, and/or using a website to generate said authorization letters.

Claim 17

Regarding claim 17 the *Action* states:

As per claims 17-22, they are system claims which repeat the same limitations of claims 1, 3, 8-10 and the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of Taylor, McCormack and APA disclose the underlying process steps that constitute the methods of claims 1, 3, and 8-10, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 17-22 are rejected for the same reasons given above for claims 1, 3, and 8-10.

The references used in the *Action* fail at least the first and third prong of obviousness in that there is no suggestion or motivation to combine the reference teachings and the references do not teach or suggest all of the limitations of claim 17. Applicants respectfully traverse this rejection in view of the preceding remarks in support of independent claim 1, *supra*. Applicant's further submit that in view of the amendments to claim 17, claim 17 is in condition for allowance when viewed in support of the remarks submitted with respect to claim 1 concerning similar amendments.

Regarding the *Action's* additional assertions toward claims 18-22, which have not been addressed specifically, Applicants do not acquiesce to said assertions and reserves

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the right to later present arguments against said assertions. Furthermore, Applicants' submit that the *Action's* rejection of claims 18-22 are moot in view of there dependency on claim 17 which, as amended and in view of the above remarks is in condition for allowance. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 18-22 in view of there dependency on claim 17.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the *Action*, and therefore do not address patentable aspects of the invention that were not addressed by the *Action*. The claims may include other elements that are not shown, taught, or suggested by the cited references. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the *Action* contains a number of statements reflecting characterization of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the *Action*.

Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 13-2725.

If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the Applicants' representative at the below-listed telephone number.

Respectfully submitted,



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